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Please find below and/or attached an Office communication concerning this application or proceeding.

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ADVISORY ACTION EXPLANATION OF REJECTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,4,6-11,13-17,19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller et al (20040031226).

Claims 1, 4, 6, 10,16, 19-21. Miller et al discloses a flexible building component for forming floor and/or wall coverings, comprising: a support layer (16) for placement on a floor or a wall to be covered; an upper layer (17-19) supported by the support layer and including at least one coating elements (any one of 17-19) and forming a visible upper surface of the building component; an intermediate layer (the adhesive layer of paragraph 0020) arranged between and connecting the support layer and the upper layer; elastic joint devices (21,22) for connecting the building component to other such building components and/or edge facing elements applied to the floor or a wall; and a bordering (24) encircling the building component and forming a visible filling of joints between coating of the upper layers of the building component and adjacent other such building components connected to the building component by said devices elements (where the layer 24 is coated on the elements and would be visible once applied),

wherein the width of the bordering encircling the building component is half as wide as the width of the joints between several coating elements (where the joint includes one element 21 and one 22 each having a layer 24 therefore the bordering element 24 is half the width of the joint as the joint comprises two borders 24); wherein: the intermediate layer and bordering are on the element (where the adhesive is also on the coupling parts as a preglue, element 24 and extends completely around the coupling parts thereby being connected to the intermediate layer), which bordering is of the same material as the intermediate layer (an adhesive as disclosed by Miller et al) wherein the support layer and the coating element are positioned at a distance relative (where they are spaced by the adhesive layer) to each other.

is foamed or sprayed on the support layer and the at least one coating element (paragraphs 0032, 0036, 0038 disclose applying the chemical adhesive glue by spray foam to provide an precise and accurate dispersion of the glue) so as to simultaneously form a bordering integrally connected to the intermediate layer and encircling the building component

It should be noted that the limitations of "are simultaneously formed in one piece in a molding cavity of a tool by foaming or spraying onto the support layer and coating element" are considered product-by-process limitations. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the

prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

In the instant case Miller does disclose applying the adhesive by spraying as noted above, but does not necessarily disclosed the process of being disposed in a tool and spaced by a molding cavity, or simultaneous forming, however the prior art product does disclose the same claimed structure. Therefore the prior art product is the same as or obvious from Applicant's claimed invention and thus the product is anticipated by the prior art even though it may be made by a another method.

Claim 7. The building component according to claim 1, wherein the intermediate layer is made of an elastic and/or water-resistant material (paragraphs 0040-0048).

Claim 8. The building component according claim 1, wherein the support layer is made of recycling material (paragraph 0021).

Claim 9. The building component according to claim 1, wherein the coating element is made of ceramic, stoneware, natural stone, glass, plastic, metal and/or wood (paragraphs 0022-0024).

Claim 11. The building component according to at claim 1, wherein the devices for connecting are connector devices (20, 22) for tongue-and-groove joints.

Claim 13. A building component according to claim 10, wherein engaging connector devices are provided (as seen in figures 2-3, particularly at elements 21,23).

Claim 14. The building component according to claim 11, wherein the groove is formed between the support layer and the layer encompassing the coating element (as seen in the figures).

Claim 15. The building component according to claim 10, wherein the edges of the support layer and of the layer encompassing the coating element are arranged offset relative to each other, parallel to the plane of the support layer (as seen in figure 2).

Claim 17. The building component according to claim 1, wherein the support layer has a surface profile (as seen in the figures).

Claim 22. The building component according to claim 1, wherein the building component is curved as a whole and/or exhibits a curved surface (at 23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (20040031226) in view of Miller et al (20030208980).

Claim 12. Miller et al. ('226) discloses the building component according to claim 11, where a tongue is formed opposite a groove, however Miller et al ('226) does not disclose that a tongue and groove are formed at two sides respectively. Rather Miller et al. ('226) discloses that a tongue and groove are formed at one side.

Miller et al. ('980) discloses a building component having layers and a tongue formed opposite a groove, where the groove is at two adjacent perpendicular sides and the tongues are opposite the grooves (figure1).

At the time the invention was made it would have been obvious to one having ordinary skill in the art to modify the component of '226 to have two perpendicular sides with a groove and the opposite sides with a tongue to improve the connection between adjacent placed building components by having a connection on all sides of the component.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al (20040031226) in view of Milborn (2548036).

Claim 18. Miller et al. discloses the building component according to claim 1, but does not disclose pipes for a heating and/or cooling, heating conductors and/or sensors are embedded in the building component in the support layer.

Milborn discloses a panel for use in flooring having layers and pipes disposed in a support layer for heating a floor made of the panels (see figures; disclosure).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the panel of Miller et al. to have the pipes as disclosed by Milborn to incorporate heating/cooling into the building component to provide efficient and space-saving thermal elements to a building.

RESPONSE TO REQUEST FOR CONSIDERATION/ ARGUMENTS

Response to Arguments

Applicant's arguments filed the advisory action dated 3/7/2011 have been fully considered but they are not persuasive.

Applicant's argument that the layer of adhesive between 17-19 and 16 as disclosed in Miller is not a layer as understood by one of skill in the art is not

persuasive. Applicant has provided no fact or evidence to support such an assertion or what one of ordinary skill in the art would understand a “layer" to be. The office asserts that the layer of Miller does constitute a "layer” as understood by one of ordinary skill in the art as it is a material of a determined thickness and that is positively positioned between the layers 17-19 and 16 thereby adhering them together. Even though the layer is an adhesive that does not mean it is not a layer. It is common to provide a layer of adhesive between elements for securing them together. Therefore applicant's arguments are not persuasive as the office considers that one of ordinary skill in the art would understand such a layer of Miller to constitute a layer, absent any fact or evidence to support otherwise, or any distinguishing feature or disclosure to distinguish Applicant's layer of that of Miller as presented above.

Applicant's argument that the layer 24 of Miller does not form a “visible filling of the joints when the building components are connected" is not persuasive as the claim does not include the limitation "when the building components are connected". Further, the layer 24 of Miller does form a visible filling of the joints as they layer coats all joining elements and can be seen at some point in the manufacture, forming, installing process and therefore is clearly visible and clearly fills the joint of connected components.

Applicant’s arguments regarding the simultaneous forming in a molding cavity is not persuasive as this is an apparatus article claims and those limitations are product by process as noted above. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product

of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). Miller discloses the product as claimed even though it may be made by another method.

/Eileen Lillis/
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/J. L./

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